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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,752	12/08/2008	Martin Imhof	MEISS71.028APC	1141

20995 7590 09/17/2009  
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EXAMINER
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HOFFMAN, MARCIA

ART UNIT	PAPER NUMBER
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3774

NOTIFICATION DATE	DELIVERY MODE
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09/17/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/596,752	<b>Applicant(s)</b> IMHOF, MARTIN	
	<b>Examiner</b> MARCIA HOFFMAN	<b>Art Unit</b> 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/22/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 5-10, drawn to a joint socket.

Group II, claim(s) 11, drawn to a method for implanting a joint socket.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical features of: a socket shell and a socket insert are common to claims 5 and 11. However, there is lack of unity *a posteriori* since all of the technical features common to all the independent claims are anticipated by Hermann (European patent no. EP 0 964 294). Hermann discloses a socket shell (2) and a socket insert (4) (see figure 2 and English abstract).

Lack of unity of invention may be directly evident "a priori," that is before considering the claims in relation to any prior art, or may become apparent "a posteriori," that is, after taking the prior art into consideration. For example, independent claims to A+X, A+Y, X+Y can be said to lack unity a priori as there is no subject matter common to all claims. In the case of independent claims to A+X and A+Y, unity of invention is present a priori as A is common to both claims. However, if it can be established that A is known, there is a lack of unity a posteriori, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

During a telephone conversation with Josue Villalta on 09/09/2009 a provisional election was made without traverse to prosecute the invention of Group I, claims 5-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn

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from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim

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will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Claim Objections***

5. Claim 5 is objected to because of the following informalities: line 11 recites “the said region,” which appears to be redundant. It is recommended that either the word “the” or “said” in this recitation is deleted. Appropriate correction is required.

6. Claim 9 is objected to because of the following informalities: the units have been omitted with regard to the number “4.5” in line 2. It is believed by the examiner that claim 9 should recite “4.5°”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 7 recites the limitation “the conically narrowing inner surface” in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) said invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Serbousek et al. U.S. publication no. 2002/0068980.

12. Regarding claim 5, Serbousek et al. disclose a joint socket (10) for a hip endoprosthesis, comprising: a socket shell (12) configured to be implanted in the pelvic bone of a patient (see paragraph [0029], lines 3-4), the socket shell having an inner surface (20) that defines an accommodating space (24) extending about an axis of rotation; and a socket insert (60) configured to provide a bearing (16) (see paragraph [0032], lines 1-2) for a joint head of a prosthesis stem, a spherical outer surface (32) of the socket insert configured to be disposed in the accommodating space of the socket shell (see paragraph [0029], line 5) and contact the inner surface along a line of contact that is concentric with the axis of rotation of the accommodating space (see figure 3), the socket insert coupleable in a self-locking manner within the accommodating space (see paragraph [0035]), wherein the inner surface of the socket shell tapers toward a pole of the shell (via taper 30) in the region of the line of contact in such a manner that a radius of curvature in the region is greater than the spherical radius of the outer surface of the socket insert (see figures 2-4, where it is understood that the socket shell tapers toward the pole of the shell in the region of the line drawn along the contact of the shell and insert such that a

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radius of curvature in the region of the taper is greater than the spherical radius of the outer surface of the socket insert).

13. Regarding claim 6, Serbousek et al. disclose the inner surface has a conical shape and defines an infinite radius of curvature in the region of the line of contact (see figures 2-3, where it is understood that the tapered regions of element 20 define a conical shape, while the area of contact further defines an infinite radius of curvature because it is circular).

14. As best understood, regarding claim 7, Serbousek et al. disclose a cone angle of the conically narrowing inner surface is a self-locking angle (see paragraph [0035], lines 5-11) corresponding to a material pairing of the socket shell and the socket insert (see paragraph [0033], where it is understood that material pairing is necessary in combining materials and interlocking components and would thus also be necessary in affixing shell and liner).

15. Regarding claim 8, Serbousek et al. disclose the cone angle of the conical inner surface is between about 4° and 10° (see paragraph [0035], where it is understood that between about 4° and 10° is encompassed within the range of zero and seventeen degrees).

16. Regarding claim 9, Serbousek et al. disclose the cone angle of the conical inner surface is about 4.5 (see paragraph [0035], where it is understood that about 4.5 degrees is an acute angle falling within the specific range of zero degrees to seven degrees).

17. Regarding claim 10, Serbousek et al. disclose the cone angle of the conical inner surface is about 9.5° (see paragraph [0035], where it is understood that about 9.5° is an acute angle falling within the specific range of zero degrees to seven degrees).

### ***Double Patenting***

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claim 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 4,894,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 5 is rejected over claim 1 of the patent. Claim 5 recites “A joint socket for a hip endoprosthesis, comprising: a socket shell configured to be implanted in the pelvic bone of a patient the socket shell having an inner surface that defines an accommodating space extending about an axis of rotation” (see lines 1-4 of patent) “wherein the inner surface of the socket shell tapers toward a pole of the shell in the region of the line of contact in such a manner that a radius of curvature in the region is greater than the spherical radius of the outer surface of said socket insert” (see lines 5-9 of patent).

The application and patent are different by the fact that the application is broader in some regards add features in other respects. The application is broader in the fact that it does not require the specifics of the self tapping threads. The application is more specific that the patent



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by the fact that it includes "socket insert configured to provide a bearing for a joint head of a prosthesis stem, a spherical outer surface of said socket insert configured to be disposed in the accommodating space of the socket shell and contact the inner surface along a line of contact that is concentric with the axis of rotation of the accommodating space, the socket insert coupleable in a self-locking manner within said accommodating space." It would have been obvious to one of ordinary skill in the art at the time of the invention to include the sleeve component in the socket component because the socket component, as claimed in the patent, is configured such as to accommodate a sleeve portion, the use of which is well-known in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCIA HOFFMAN whose telephone number is (571) 270-1456. The examiner can normally be reached on Monday thru Friday, 10:00 a.m. - 6:00 p.m., Est. (alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Stewart/

Primary Examiner, Art Unit 3774

/MARCIA HOFFMAN/

Examiner, Art Unit 3774